

### **REMARKS**

By this Reply, Applicants amend claims 1, 15, 18, 19, 22, 28 and 34 and add new claims 35-40. Claims 1-40 are therefore pending in this application, with claims 1, 22, 28 and 34 being independent. Support for the claim amendments and new claims can be found throughout Applicants' disclosure, for example, at pages 17-20 and 44-50 and Fig. 18. No new matter has been introduced.

In the Office Action of March 14, 2007 ("Office Action"), claim 28 was rejected under 35 U.S.C. § 101; claims 15, 18 and 19 were rejected under 35 U.S.C. § 112, second paragraph; claims 1-8, 11 and 22-34 were rejected under 35 U.S.C. § 102 based on U.S. Patent No. 5,880,731 ("*Liles*"); and claims 9, 10 and 12-20 were rejected under 35 U.S.C. § 103(a) based on *Liles* in view of WO 01/84461 A1 ("*Kim*"). Applicants address these rejections and the new claims below.

#### **Section 101 rejection**

The Office Action asserts that independent claim 28 is directed to non-statutory subject matter. According to the Office Action, claim 28 is directed to non-statutory natural phenomena because it recites "a propagated signal." Office Action, p. 2.

Applicants have amended claim 28 to recite, *inter alia*, "[a] computer-readable medium having embodied thereon a computer program . . . the computer program comprising one or more code segments . . . ." As articulated in M.P.E.P. § 2106(I), "a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory" (internal citations omitted). Applicants submit that claim 7, and its dependent claims 29-33, are directed to statutory subject matter and do not cover or preempt any §101 judicial exception. Applicants accordingly request withdrawal of the section 101 rejection.

In response to the assertions in the Office Action regarding functional descriptive material, Applicants call attention to M.P.E.P. § 2106.01(I). See Office Action, p. 2. This section of the M.P.E.P. makes clear that "[o]nly when the claimed invention taken as a whole is

directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.” Here, Applicants’ claims do not merely recite a computer program listing. Rather, independent claim 28 and its dependent claims 29-33 are directed to “a computer-readable medium” having embodied thereon a computer program comprising one or more code segments that, when executed, are configured to perform certain recited operations. For at least these additional reasons, Applicants request withdrawal of the section 101 rejection.

### **Section 112 rejection**

The Office Action asserts that claims 15, 18 and 19 are indefinite because there is insufficient antecedent basis for the recitation of “the setting characteristic” in these claims. By this Reply, Applicants change the dependency of claims 15, 18 and 19 so that these claims now depend upon claim 13, which provides the antecedent basis for “the setting characteristic.” Applicants submit that claims 15, 18 and 19, as currently presented, are fully compliant with section 112, second paragraph, and thus request withdrawal of the rejection.

### **Section 102 rejection**

The section 102 rejection of pending claims 1-8, 11 and 22-34 should be withdrawn because *Liles* fails to anticipate these claims, as now amended. In order to properly anticipate Applicants’ claims under section 102, a single prior art reference must disclose each and every element of the claim at issue, either expressly or under principles of inherency. Here, the applied art fails to disclose each and every feature of the claims.

Amended independent claim 1 recites a method for animating a first avatar based on perceived animation of a second avatar. The method comprises graphically representing, on a first system, a first user with a first avatar capable of being animated and graphically representing, on the first system, a second user with a second avatar capable of being animated wherein communication messages are being sent between the first user and the second user. The method further comprises receiving an indication of an animation of the first avatar. The method comprises accessing information associating animations of avatars. The method comprises identifying, based on the accessed information, an animation for the second avatar that is

responsive to the indicated animation of the first avatar. In addition, claim 1 recites animating the second avatar, in response to the received indication, based on the identified responsive animation.

*Liles* is directed to animating avatars. *See* Abstract. In *Liles*'s system, a user can select an avatar that will represent the user in a chat session. As the Office Action notes, *Liles* discloses that the user can select an animation of the avatar that conveys a desired emotion and/or state of mind to another user in the chat session. *See* Office Action, p. 3; *see Liles*: col. 3, lines 32-41. *Liles* also describes automatically initiating certain avatar gestures at random times, for example, at an idle period in a chat session. *See* col. 9, lines 15-32; col. 14, lines 22-26.

*Liles* fails to disclose at least the above-identified "accessing" and "identifying" features of claim 1. *Liles* merely describes that a user can select animations for avatars and that certain animations can be automatically initiated at random times. The reference does not disclose accessing any information associating animations of avatars. Likewise, the reference fails to disclose identifying, based on the accessed information, an animation for a second avatar that is responsive to an indicated animation of a first avatar.

The Office Action asserts that, in *Liles*'s system, a participant can select an initiate an animation employing the avatar in response to an animation of the other participant's avatar. Office Action, p. 3. This assertion serves to illustrate a distinction between claim 1 and *Liles*. Indeed, in *Liles* system, any animation of an avatar responsive or reactive to an animation of another avatar would be identified, if at all, by a user selection. The reference does not disclose accessing information associating animations of avatars and identifying, based on the accessed information, an animation for a second avatar that is responsive to an indicated animation of a first avatar.

Because *Liles* fails to disclose each and every feature of claim 1, the section 102 rejection of claim 1 based on that reference should be withdrawn. The section 102 rejection of claims 2-8 and 11 should be withdrawn as well, since these claims depend upon claim 1 and are likewise distinguishable from *Liles*.

Independent claims 22, 28 and 34, although different in scope from claim 1 and each other, recite subject matter similar to that in claim 1 discussed above. Claim 22 recites a system for animating a first avatar based on perceived animation of a second avatar. The system

comprises a processor configured to, *inter alia*, access information associating animations of avatars and identify, based on the accessed information, an animation for the second avatar that is responsive to the indicated animation of the first avatar.

Claim 28 recites a computer-readable medium having embodied thereon a computer program configured to animate a first avatar based on perceived animation of a second avatar. The computer program comprises one or more code segments that when executed are configured to, *inter alia*, access information associating animations of avatars and identify, based on the accessed information, an animation for the second avatar that is responsive to the indicated animation of the first avatar.

Claim 34 recites a system for animating a first avatar based on perceived animation of a second avatar. The system comprises, *inter alia*, means to access information associating animations of avatars and means to identify, based on the accessed information, an animation for the second avatar that is responsive to the indicated animation of the first avatar.

Independent claims 22, 28 and 34 are distinguishable from *Liles* for at least reasons similar to those presented above in connection with claim 1. The section 102 rejection of these claims should therefore be withdrawn. The section 102 rejection of dependent claims 23-33 should be withdrawn as well, since these claims depend upon claim 22 and are likewise distinguishable from the applied art.

### **Section 103 rejection**

Each of claims 9, 10 and 12-20 depends upon claim 1. As discussed above, *Liles* fail to disclose or suggest each and every feature of claim 1. *Kim*, which was applied to certain features of claims 9, 10 and 12-20, relates to changing a screen image containing an avatar acting in a virtual space and a background image. *See* Abstract. As noted in the Office Action, *Kim* discloses that the screen image changes include, for example, changes in weather conditions. *See* Office Action, p. 5; *see Kim*: p. 2, lines 5-14. *Kim* does not cure the deficiencies of *Liles* with respect to independent claim 1, or independent claims 22, 28 and 34. Accordingly, *Liles* and *Kim*—whether taken alone or in any combination—fail to disclose or suggest each and every feature of claim 1 or its respective dependent claims 9, 10 and 12-20.

Moreover, Applicants submit that a skilled artisan would not have been led to modify or combine *Liles* and *Kim* in a manner resulting in a combination as is recited in claim 1, 9 or 10 or any of claims 12-20. Applicants submit that a skilled artisan facing whatever need or problem known in the relevant field, would not have been led to modify or combine these references in a manner resulting in Applicants' claimed combinations, without first consulting Applicants' disclosure. See *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. \_\_\_, 2007 WL 1237837 (Apr. 30, 2007).

For at least the foregoing reasons, *Liles* and *Kim* fail to support a case for *prima facie* obviousness with respect to claims 9, 10 and 12-20. The section 103 rejection of these dependent claims should therefore be withdrawn.

#### **New claims 35-40**

Each of new claims 35-40 depends upon claim 1, 22, 28 or 34 and is similarly distinguishable from the applied references. Applicants submit that the applied references further fail to disclose or suggest the additional features recited in these new dependent claims. Applicants accordingly request the timely allowance of new dependent claims 35-40.

#### **Conclusion**

Applicants request the Examiner's reconsideration of the application in view of the foregoing and the timely allowance of pending claims 1-40.

It is believed that all pending issues in the outstanding Office Action have been addressed by this paper. The Office Action, however, contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action. In addition, there may be reasons for patentability of any or all pending or other claims that have not been expressed above.

If there are any questions regarding this paper or the application generally, Applicants would appreciate a telephone call to the undersigned since this may expedite prosecution of the application.

The fee in the amount of \$300 in payment of the excess claims fee is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please grant any extensions of time required to enter this paper and apply any other required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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